

REMARKS/ARGUMENTS

I. STATUS OF THE PENDING CLAIMS

Claims 1-29 are pending in the application, all rejected. Claims 1, 3-5, 9-15, 17-20, 22, 24, and 28-29 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by JP 2003334149 ("JP1"). Claims 6, 23 and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1, in view of WO 2005/016085 ("the PCT Publication"). Claims 7, 8, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1, in view of U.S. Patent No. 5,123,130 to Sanders ("Sanders"). Claims 2 and 16 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1, in view of JP 2004016301 ("JP2"). Claim 21 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1, in view of U.S. Patent Publication No. 2003/0135186 to Olsen et al. ("Olsen").

Claims 23 and 25 and the specification have been amended non-substantively. No new subject matter has been added.

II. REJECTIONS UNDER 35 U.S.C. § 102(b) OVER JP 2003334149

Claims 1, 3-5, 9-15, 17-20, 22, 24 and 28-29 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by JP1.

A rejection of claims as anticipated under 35 U.S.C. § 102(b) requires a showing that each and every claim limitation be identically disclosed in the applied reference. If even one claim limitation is not disclosed in the reference, the claim is patentable over the reference.

Applicant respectfully submits that the rejections of claims 1, 3-5, 9-15, 17-20, 22, 24 and 28-29 are traversed on the basis of the following arguments.

Independent claims 1, 15 and 17, and the claims which depend from them, recite that the matting used in proximity to a base of a toilet to be *disposable*. JP1 does not disclose a toilet mat comprising matting, the matting comprising *disposable*, absorbent material, as claimed.

Proper examination of the claims requires precise understanding of the claim terminology and, specifically, the "disposable" limitation. Applicant fears the rejection is predicated upon a fundamentally mistaken interpretation of this term.

The word "disposable" as recited in the claims has a clear, universally accepted meaning. According to Merriam-Webster:

"Main Entry: ¹dis·pos·able

Pronunciation: di-'spO-z&-b&l

Function: *adjective*

1 : subject to or available for disposal; *specifically* : remaining to an individual after deduction of taxes and necessary living expenses <*disposable income*>

2 : *designed to be used once and then thrown away* <*disposable diapers*>"

See www.m-w.com (disposable)(emphasis supplied).

Merriam Webster provides two definitions of the word "disposable". The first refers to disposable income, a concept plainly not involved in the claims.

The second definition, however, squarely fits the usage in the claims: "designed to be used once and then thrown away." The example of disposable diapers underscores that this second definition is on point.

Applicant has not provided any special definition of disposable, much less any definition that conflicts with or is in any way contradicted by its plain meaning.

The rejection is based on a wholly erroneous interpretation of "disposable". The Examiner, without the benefit of any dictionary or other authority as to the meanings of words, states that "Any article is 'disposable' merely by the desire of the user." (Office Action p. 3.) Not true. This assertion is flatly contradicted by the demonstrated plain meaning of "disposable", as well as the usage of "disposable" in the application and the claims.

By the Examiner's logic, diamonds, brand new automobiles, homes, ocean liners and even human lives, are disposable -- propositions that no rational person could agree with. "Disposable" most certainly does not mean capable of being disposed of. Interpreting the word in this way not only is incorrect, as made clear above by quotation to a leading arbiter of American English usage, but it would positively render the word meaningless. An object, such as a Rembrandt painting, is not disposable simply because a person in an act of economic irrationality can throw it away. A paper cup, on the other hand, *is* disposable -- as is universally understood.

The Examiner may be mistaking "disposable" with replaceable. These, however, are distinct concepts. An object can be replaceable without being disposable, as that word is correctly understood. Nothing in JP1 suggests using disposable material. Any mat disclosed in that reference may very well be retained for any number of uses and replaced merely for purposes of cleaning or reconditioning.

The distinction over JP1 is also clear from the fact that, as the present application clearly explains, disposability involves structural features, e.g. "any material intended to be used until soiled, that is, a small number of time[s], or [even] a single time, single-use or otherwise disposable, as distinguished from a mat or rug of fabric that wouldn't ordinarily be intended to be used only once or a small number of times until soiled." (Application p. 4, ll. 3-7.) Furthermore, "the material, or materials are ... most preferably disposable materials, as opposed to ... material used in those toilet mats that are known in the art for repeated, indefinite use." (*Id.* p.4, ll. 20-23.) We respectfully disagree with the Examiner's argument that the disposable feature of the present application is not indicative of a structural difference.

For these reasons, independent claims 1, 15, and 17 which include the disposability limitation, and dependent claims 3-5, 9-14, 16, 18-20, 22, 24, and 28-29 are respectfully submitted to recite allowable subject matter.

**III. REJECTIONS UNDER 35 U.S.C. § 103(a)
OVER JP 2003334149 AND WO 2005/016085**

Dependent claims 6, 23 and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1 in view of the PCT Publication.

A rejection under 35 U.S.C. § 103(a) requires the establishment of a *prima facie* case that the claimed subject matter, including all claim elements, would have been obvious to a person having ordinary skill in the art on the basis of either a single prior art reference or more than one reference properly combined. No such *prima facie* case has been established for these claims. Applicant respectfully traverses these rejections, as set forth more fully below.

First, as discussed above, JP1 does not disclose the invention as recited in independent claims 1 and 17, from which claim 6, and claims 23 and 25, respectfully, depend. For this reason alone, the rejections lack merit and should be withdrawn.

In addition, however, the rejection supplies no motivation, other than a conclusory contention that "there is an abundance of suggestion in the like nature of the two devices" (Office Action p. 4) to combine the disclosures of JP1 and the PCT Publication. For this additional reason, the rejections of claims 6, 23 and 25 should be withdrawn.

**IV. REJECTIONS UNDER 35 U.S.C. § 103(a) OVER
JP 2003334149 AND U.S. PATENT NO. 5,123,130**

Dependent claims 7, 8, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1 in view of Sanders.

Applicant, again, respectfully disagrees. As discussed above, Applicant has submitted that JP1 does not disclose the invention as recited in independent claims 1 and 17, from which claims 6 and 7, and claims 26 and 27, respectively, depend. The rejections, for this reason alone, should be withdrawn.

Claims 6, 7, 26 and 27 recite illuminated footprint-shaped indicia on the mat for encouraging a person to stand on. Sanders allegedly discloses the use of footprints of a luminous

nature employed in a bathroom environment. However, Sanders, at most, provides illuminated footprints to help children find the bathroom at night. Furthermore, the rejection supplies no motivation to combine the disclosures of JP1 and Sanders. Dependent claims 7, 8, 26 and 27 have nothing to do with providing illuminated paths to the bathroom, so Sanders actually teaches away from a combination of the references. For these additional reasons, the rejections of dependent claims 7, 8, 26 and 27 should be withdrawn.

**V. REJECTIONS UNDER 35 U.S.C. § 103(a)
OVER JP 2003334149 AND JP 2004016301**

Dependent claims 2 and 16 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1 in view of JP2.

As discussed above, Applicant has submitted that JP1 does not disclose the invention as recited in independent claims 1 and 15, from which claims 2 and 16, respectively, depend. The rejections, for this reason alone, should be withdrawn.

Claims 2 and 16 have been rejected as obvious over JP1 in combination with JP2. Claims 2 and 16 recite an adhesive collar for adhering the periphery of a cut-away region to the toilet for creating a seal and preventing the mat from slipping.

JP2 is said to disclose this additional limitation. On its face, however, JP2 nowhere discloses an adhesive. It is unclear how the "covering cloth" 3 remains in position. Items 51 and 52 of the figure in JP2 are not described and, if anything, appear to represent use of an attaching structure, rather than an adhesive because the combination 5 of the above items is described in the English translation as a "surface fastener." For this additional reason, the rejection of claims 2 and 16 should be withdrawn.

VI. REJECTIONS UNDER 35 U.S.C. § 103(a) OVER

JP 2003334149 AND U.S. PATENT PUBLICATION NO. 2003/0135186

Claim 21 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP1 in view of Olson. Claim 21 involves use of an olfactory indicator. This feature is said to be disclosed by Olson. Applicant disagrees and objects to the combination of Olson with JP1.

Whereas JP1 relates to a mat, Olson relates to wearable articles, which are not analogous to mats. Moreover, one of skill in the art would need to use Applicant's disclosure as a guide to pick and choose among the references, assuming without conceding the combination with Olson were otherwise proper, to arrive at Applicant's claimed invention. Such hindsight selection is not an appropriate basis for an obviousness rejection, and the Examiner's reasoning that both references disclose "absorbent articles used for bodily waste having an odor" is indicative of such hindsight reasoning which is explicitly prohibited. Still further, the failure of JP1 to disclose a disposable mat further suggests that it cannot be combined with the Olson's wearable articles, which are explicitly disposable.

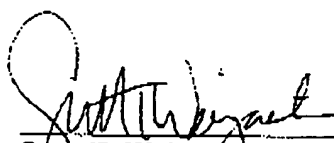
For these reasons, the combination of JP1 and Olson is respectfully submitted to lack merit. Accordingly, Applicant requests the withdrawal of the rejection.

VII. CONCLUSION

Claims 1-29 of the Application are submitted, as now pending, to distinguish patentably over the art of record. The Commissioner is authorized to charge any fees required to maintain pendency of the above-captioned application to Deposit Account No. 23-1703.

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Respectfully submitted,



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